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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,421	01/10/2002	David P. Billings	DOG 2410000	9060
7590	02/12/2004		EXAMINER	
Gregory W. Carr CARR & STORM, L.L.P. 670 Founders Square 900 Jackson Street Dallas, TX 75202			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	10
DATE MAILED: 02/12/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

JK

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/043,421	BILLINGS, DAVID P.	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 05 January 2004.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

<ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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10/043421

### DETAILED ACTION

This Office action is responsive to communication received 01/05/2004 – RCE and Amendment B.

Claims 1-24 remain pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language "displacing an exterior displacement and having walls forming a cavity therebetween having an interior volume that, prior to displacement of any material in the interior cavity, comprises the major portion of said exterior displacement" does not make any sense. How can an interior cavity displace an exterior volume? While applicant's comments provided with the 01/05/2004 amendment attempt to explain the natural occurrence of displacement of an object within a medium (air, liquid or gas), the explanation does little to explain the nomenclature used to define a hollow club head. The applicant appears to be trying to define a hollow club head structure using a rather unconventional and unorthodox approach, which simply makes for a confusing claim. As an example, why not simply say that the club head (100) comprises a plurality of relatively thin shell pieces comprising a crown portion (114), a face portion (110), a sole portion and a wall portion (112) that collectively form a hollow body with a substantially empty or voided cavity, with a port formed through the housing to allow placement at one or more positions on an inside surface of at least one of said crown, face, sole and wall portions. Note, the reference numbers here are used for illustrative purposes only and need not be incorporated within the actual claim language to define the invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the language, "displacing an exterior displacement and having walls forming a cavity there between having an interior volume that, prior to displacement of any material in the interior cavity, comprises the major portion of said exterior displacement" is not detailed in the originally filed specification.

Claims 1, 2, 4, 5, 7, 10, 13, 14, 16, 19 and 21 are rejected under 35 USC 102(b) as being anticipated by Wakita. As to claims 1, 10 and 19, Figure 4 shows a club head (10) with a face (13), crown (14) side walls (not numbered) and sole portion (20). These parts form a hollow cavity within a substantially thin-walled structure. A port (opening) is provided through which a weighting material (24) may be placed within the hollow structure. As to claims 2, 10, and 19, note element (19) serving as a port closure. As to claims 4 and 13, the port is located on the sole side of the head. As to claims 5 and 14, Wakita contemplates placing the opening on a crown side, but does not recommend such placement of the port and closure for aesthetic reasons (col. 4, lines 8-22). As to claims 7 and 16, Wakita is clearly directed to a club of the wood-type. As to claim 21, Figure 4 clearly shows that the cover (19) fits in a flush manner with the remainder of the sole wall surface.

Claims 1, 2, 6, 8, 10, 15, 17 and 19 are rejected under 35 USC 102(b) as being anticipated by Takeda. Note Figure 4 and the description in column 4, line 66 through column 5, line 50, wherein Takeda details an iron-type club head with a main body (1), a

hollow interior (8), a port or opening closed by cover (17) and a weight material (26) placed within the hollow interior.

Claims 1, 2, 3, 4, 9, 11, 12, 13, 18, 22, 23 and 24 are rejected under 35 USC 102(b) as being anticipated by MacIntyre. As to claims 1, 10 and 19, note that the MacIntyre device includes a top surface (11), sole (10), striking face (12) and peripheral heel and toe ends (17, 18). The assembly creates a substantially hollow interior that is sealed off by a cover plate (36) and retains weight members therein. As to claims 2, 10 and 19, here again, note cover (36). As to claims 3, 12, 22, 23 and 24, note the language in column 3, lines 16-45, wherein MacIntyre details that hard rubber washers (45) that are slightly compressed are used just below the cover plate (36) to help prevent rattling of the weight members. As to claims 4 and 13, the port is located in the sole portion of the head. As to claims 9 and 18, MacIntyre clearly shows a putter-style club head.

Since the claims are indefinite under 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph, the claims are still being considered with substantially the same limitations first set forth upon filing. Thus, all the rejections based on prior art set forth in the prior Office action are still deemed applicable, here. These rejections are set forth below for the convenience of the applicant.

Claims 1, 2, 4, 8, 10, 13, 17, 19 and 21 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Sun ('879), as set forth in the Office action, mailed 11/01/2002.

Claims 1, 2, 5, 8, 10, 14, 17, 19 and 21 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Churchward ('934), as set forth in the Office action, mailed 11/01/2002.

Claims 1, 2, 6, 9, 10, 11, 12, 15, 18-22 and 24 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Mills, as set forth in the Office action, mailed 11/01/2002.

Claims 1-4, 7, 10-13, 16, 19 and 21-24 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Held, as set forth in the Office action, mailed 11/01/2002.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nagamoto shows a substantially hollow shell that may be selectively filled with a weighting material. The sole includes an opening that may be closed with a plate (5). Weight members (30) in Zebelean may be selectively placed inside the relatively thin, substantially hollow metal shell of Zebelean. Note weight (16) in Minabe. Note weight (36) in Moore. Kochevar shows a weight material (31) within a hollow head. Helmstetter ('958) and ('788) and (624) show a hollow shell, of interest. Fritz shows a hollow club head. Note the placement of the weights in Teramoto.

#### RESPONSE TO ARGUMENTS

In the arguments received 01/05/2004, the applicant contends that none of the prior art references of record show or suggest the claimed invention including an exterior displacement and having walls forming a cavity therebetween having an interior volume that, prior to placement of any material in the interior cavity, comprises the major portion of said exterior displacement. Further, the applicant contends none of the

prior art devices of record show club heads having selectively closeable ports that permit placement of material within the club head to adjust the location of the center of gravity, wherein the volume of the interior cavity comprises the major portion of the exterior displacement of the housing on a volumetric basis, prior to any material being placed within the cavity. Instead, the applicant argues that the club heads of the prior art all have cavities that comprise a minor portion of the exterior displacement of the club head on a volumetric basis.

In response to these arguments, it is noted that the language that the applicant has both added to the claims and relied upon to define over the prior art of record is indefinite in meaning and not detailed by the originally filed specification. The originally filed specification does not state or reference any comparison between an interior volume and the amount of displacement of the exterior of the head. The claim language does not preclude the existence of further structure within the interior of the head, as the claims are still cast in open terminology, i.e., a golf club head comprising. The prior art clearly reveals that weights may be selectively placed within the interior of a hollow golf club head structure to selectively shift the location of the center of gravity. The previous rejections based on Sun ('879), Churchward ('934), Mills and Held are clearly applicable given the broadest, reasonable interpretation of the claims, as originally filed and considering that language added to the claims throughout prosecution still renders the claims indefinite. The newly cited rejections in the current Office action and relying on the prior art references to Wakita, Takeda and MacIntyre are more inline with an

interpretation of the claims involving limitations that the applicant is attempting to incorporate into the claims to detail a substantially hollow interior.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
February 8, 2004